

## **REMARKS/ARGUMENTS**

### **Status of Claims**

Claims 1-26 were pending in this application before the present response. In the Office Action dated January 15, 2008, claims 1-2 and 14-15 stand rejected under 35 U.S.C. § 102(b), and claims 3-13 and 16-26 stand rejected under 35 U.S.C. § 103(a).

No claims have been amended in this response. No new matter is added. Any remarks made herein with respect to a given claim is intended only in the context of that specific claim, and should not be applied to other claims, amendments, or aspects of Applicants' invention.

Claims 1-26 are now pending in this application. Applicants respectfully request reconsideration and allowance of all pending claims, in view of the following remarks.

### **Claim Rejections – 35 U.S.C. § 102**

Claims 1-2 and 14-15 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 6,490,002 to Shintani (hereinafter “Shintani”). Applicants respectfully traverse the rejection.

Shintani discloses a high definition television (HDTV) that “has separate inputs for the analog signal and the high definition digital signal, which is decoded in the HDTV to a format suitable for display on the HDTV monitor” (Shintani, Abstract).

The present application discloses methods and apparatus by which a “source device passes the on-screen display (OSD) through an MPEG encoder to produce an isochronous MPEG data stream, which can be passed over an IEEE-1394 connection to the sink device.” (Page 4, lines 12-14.) The source device is a device such as a “cable/satellite/off-air television receiver terminal” (page 2, line 3) or a “cable television receiver terminal” (page 4, lines 24-25), e.g., a set-top box. The sink device is, for example, “a high definition television (HDTV)” (p. 2, line 4).

In the present application, independent claim 1 recites “encoding the on-screen display at the source device as an isochronous MPEG data stream,” and independent claim 14 recites a “source device . . . comprising . . . an MPEG encoder adapted for

encoding said graphic data as an isochronous MPEG data stream carrying said on-screen display”.

The Office Action incorrectly states that Shintani discloses this feature. The Office Action cites Shintani at col. 7, lines 21-43 and Fig. 5, element 370, for this feature, contending that “Necessarily, since the video stream is MPEG encoded, the OSD must also be MPEG encoded at the STB to decode the MPEG signal by the MPEG decoder of the HDTV” (Office Action, page 2).

Applicants respectfully point out that, notwithstanding the inference made in the Office Action, Shintani fails to disclose that the OSD is MPEG encoded in the STB. The feature of “encoding the on-screen display at the source device as an isochronous MPEG data stream” is not taught or disclosed by Shintani. To the contrary, Shintani teaches disadvantages of encoding the on-screen display at the STB (see col. 2, lines 29-53).

Because Shintani fails to disclose “encoding the on-screen display at the source device as an isochronous MPEG data stream,” as recited in independent claim 1, and fails to disclose a “source device . . . comprising . . . an MPEG encoder adapted for encoding said graphic data as an isochronous MPEG data stream carrying said on-screen display,” as recited in independent claim 14, claims 1 and 14 are not anticipated by Shintani. Claims 2 and 15, which depend respectively from claims 1 and 14, are also not anticipated by Shintani at least by virtue of their dependency upon allowable base claims.

As Shintani fails to disclose each and every element of claims 1-2 and 14-15, Applicants respectfully submit that claims 1-2 and 14-15 are not anticipated by Shintani, and request that the rejection of claims 1-2 and 14-15 under 35 U.S.C. § 102(b) be withdrawn.

### **Claim Rejections – 35 U.S.C. § 103**

Claims 3-13 and 16-26 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Shintani in view of U.S. Pat. No. 6,137,539 to Lownes et al. (hereinafter “Lownes”). Applicants respectfully traverse the rejections.

For at least the reasons previously stated above, independent claims 1 and 14 are

allowable. Likewise, dependent claims 3-13 and 16-26, which depend on claims 1 and 14 respectively and incorporate all of the limitations thereof, are similarly patentable. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3-13 and 16-26 under 35 U.S.C. § 103(a).

Lownes fails to disclose “encoding the on-screen display at the source device as an isochronous MPEG data stream,” as recited in independent claim 1, and fails to disclose a “source device . . . comprising . . . an MPEG encoder adapted for encoding said graphic data as an isochronous MPEG data stream carrying said on-screen display,” as recited in independent claim 14. Since Lownes fails to supply features missing from Shintani, the combination of Shintani and Lownes cannot suggest the presently claimed invention and cannot render the claims obvious. Thus, no matter how Shintani and Lownes may be combined (even assuming, *arguendo*, that one of ordinary skill in the art would be led to combine them) the resulting combination is not the invention recited in dependent claims 3-13 and 16-26.

Furthermore, the combination of Shintani with Lownes, or with other prior art references, is an improper basis for rejecting Applicants’ claims at least because Shintani **teaches away** from the presently claimed invention.

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)). Shintani specifically teaches disadvantages of encoding the on-screen display at the STB (see col. 2, lines 29-53). Thus, a person of ordinary skill, upon reading the Shintani reference, would be led in a direction divergent from the path that was taken by the Applicants. Therefore, Applicants respectfully submit that Shintani fails to provide a basis for a rejection under 35 U.S.C. § 103. Because Shintani is an **improper basis** for rejecting Applicant’s claims, the combination of Shintani with Lownes, or with any other prior art references, is also an improper basis for rejecting Applicants’ claims.

For at least the reasons previously stated, independent claims 1 and 14 are allowable. Likewise, dependent claims 3-13 and 16-26, which depend on claims 1 and 14 respectively and incorporate all of the limitations thereof, are similarly patentable. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3-13 and 16-26 under 35 U.S.C. § 103(a).

### **Conclusion**

In view of the foregoing discussion, it is believed that claims 1-33 are allowable over the cited art. Applicants respectfully submit that all pending claims are in condition for allowance, and earnestly request that all rejections of the claims be withdrawn and a Notice of Allowance be entered at the earliest date possible.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

Respectfully submitted,  
CHRISTOPHER J. STONE, et al.

Date: May 15, 2008

BY: /Stewart M. Wiener/  
Stewart M. Wiener  
Registration No. 46,201  
*Attorney for Applicants*

MOTOROLA, INC.  
101 Tournament Drive  
Horsham, PA 19044  
Telephone: (215) 323-1811  
Fax: (215) 323-1300